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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,787	10/30/2003	Giuliano Morotti	2541-1012	7751

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EXAMINER

LONEY, DONALD J

ART UNIT PAPER NUMBER

1772

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,787

Applicant(s)

MOROTTI ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to support the first, second and third sections of the support being joined as in claims 8, 9 and 14. The specification also fails to provide support for the synthetic stone per claims 10 and 15.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 8, 9 and 14, "parallel air volumes running the length of the support located between the first surface section and first of the second surface sections, between each of the second surface sections, and between a last of the second surface

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sections and the third surface section" are recited. It is unclear as to what the "first of the second surface sections" and "a last of the second surface sections" refers to. It appears a word may be missing after the terms "first" and "last" since it is unclear as to what they pertain to. In claims 10 and 15 an improper Markush group appears. Proper language is either 1) "selected from the group consisting of A, B and C" or 2) "selected from A, B or C".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 8, 9, 11-14 and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexander (2253219).

Alexander discloses a flexible support (12, 13 and/or 13), first and third rectangular surface elements 11 and a plurality of second rectangular surface elements (the smaller sections located between the parallel air volume recesses 15). The flexible article being bent into an orthogonal position in figure 4 with a quarter circle surface formed at the bend. The air volume recesses being triangular in this position as shown in figure 4. All sections are bonded with glue. All the second surface elements are of the same size per claim 20 and the first and third sections are of a different size than the second elements per claim 21. Refer to figures 1, 2 and 4 along with page 1, column 1, line 19 through page 1, column 2, line 53.

Claim Rejections - 35 USC § 103

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 8, 9, 11-14 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Ruby (5323762, 5618601 or 5824382) or FR 2636936.

All of the above references teach rectangular surface elements that have a space or recess there between extending the width of the whole body, being glued to a flexible substrate wherein the upper edge of the elements touch when the composite is bent due to there spacing on the flexible substrate. Refer to figures 1, 8 and 13 in Ruby '762 showing the spaced sections 13, 14, 15 adhesively 26, 28 bonded to flexible

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backing 20, 25 or 27. Refer to figures 1a 3A, 3B and 3C in Ruby '601 showing a similar structure as to Ruby '762. Refer to figures 1a, 3a in Rudy '382. Ruby '762 shows different sized elements in figure 13. Refer to figure 3 in FR 2636936 cited by the applicant and reported on the search report as an X reference. The examiner has included an English translation for the applicant reference. The references do fail to specifically disclose the flexible support being bent at an orthogonal angle as recited. All of the Rudy patent are substantially the same in their teaching, therefore, the examiner will refer to the '392 one for teachings as to the degree of bending. At column 3, lines 6-58 and column 6, lines 18-24, Ruby discloses that the spacings, height and width of the rib members are what controls the degree of bending and that one can adjust the degree of bendability by varying these parameters in order to conform the bend to a particular application.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references to position the elements as desired in order to conform to a particular bend (i.e. orthogonal), motivated by the fact the references teach that it is known to vary the bendability by the spacing of the elements and one could do so in order to fit to any desired particular application that arises.

10. Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruby '762, '601 or '382 or FR 2636936 as applied to claims 8, 9, 11-14, 16-21 above, and further in view of any of Dratler (2680319), Burchenal et al (2887867) or Stout (3077059).

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The primary reference teaches the invention substantially as recited except for the elements being tiles and/or stones. See the 35 U.S.C. 102 rejection above.

All of Dratler, Burchenal et al and Stout disclose the attachment of tiles (i.e. ceramic) and/or bricks (i.e. stone) to a flexible backing. Refer Figures 2, 3 and 5, along with column 1, line 36 through column 2, line 44, in Dratler showing tile sections (2 or 8) spaced apart and glued to the flexible backing (5 or 10). Refer to figures 3 and 11, along with column 2, lines 27-53 and column 8, lines 52-67, in Burchenal et al showing tiles 10 that are spaced from one another bonded to flexible backing 11. See the bricks 18 in Stout. Stout is of particular relevance since bending is shown in figure 2.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references to use tile and/or stone elements attached to the flexible support, as taught by the secondary references, in order to form an exterior tile and/or stone surface therefrom after bending.

Response to Arguments

11. Applicant's arguments with respect to claims 8-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

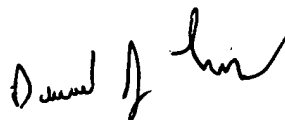
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Donald Loney", written in a cursive style.

Donald Loney
Primary Examiner
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DJLD.Loney
12/28/05

Continuation of Attachment(s) 6). Other: copy of english translation of FR 2636936.